

## **REMARKS**

This is a response to the Office Action of September 15, 2006.

### **I. SUMMARY OF OFFICE ACTION**

Claims 1, 4-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MULLER, ET AL in view of NODA and further in view of ENGEL, ET AL (U.S. Patent No. 4,791,799), and KISHIKAWA, ET AL (U.S. Patent No. 4,503,699). Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over KUBOTA in view of NODA. Claims 13-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by KOBYZEV.

### **II. APPLICANT'S RESPONSE**

By this Amendment, Claims 5-11, 13-16, 18 and 19 have been cancelled. Claims 1, 4, 12 and 17 have been amended.

#### **A. Claims 1, 4, 12 and 17**

##### **1. Modifying Muller Device With Two High Edging Stand Of Noda May Render The Muller Device Inoperable For Its Intended Use**

Claim 1 recites that the intermediate working section comprises a two-high edging stand. Applicant respectfully submits that there is no motivation to modify the MULLER device such that the Muller upsetting stand is replaced with a two-high edging stand of Noda. The reason is that the upsetting stand functions in a different manner compared to the two-high edging stand. As such, it is unclear whether the Muller device is able to accomplish its intended purpose if the MULLER device is modified such that its upsetting stand is replaced with the two-high edging stand of NODA. MPEP 2143.01 recites that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. As such, there is no motivation to modify the Muller device so as to incorporate the two high edging stand of Noda based on a contention that it is unclear whether the Muller device modified with the two high edging stand of Noda will still be able to accomplish its intended purpose. Moreover, there is no reasonable expectation of success as required by MPEP 2142.

**2. Long Felt But Unresolved Need Leads To Conclusion Of No Motivation To Combine**

There does not appear to be any motivation to modify the MULLER device such that the first and second universal stand and the two-high edging stand simultaneously hold the bar during rolling operations. The secondary considerations for non obviousness, namely, the long felt but resolved need leads to the conclusion that there is no motivation to combine the two high edging stand of Noda into the Muller device. In support thereof, the filing date of the NODA application is October 26, 1962, whereas the filing date of the MULLER application is May 7, 1997. For more than thirty years, it does not appear that anyone has combined the teachings of NODA (i.e., two high edging stand) into devices similar to the MULLER device. Although the problem of maintaining the heat of the bar has been known since 1962 (i.e., the filing date of the NODA application), it does not appear that anyone has incorporated the teachings of NODA into devices similar to the MULLER device. Hence, the long felt but unresolved need of the prior art evidences that such combination is not obvious.

**3. Examiner Has Not Provided Any Teaching, Suggestion Or Motivation To Modify The Muller Device With The Two High Edging Stand Of Noda**

Applicant respectfully submits that the Examiner has not shown any teaching, suggestion or motivation to combine the teachings of NODA (i.e., two high edging stand) into the device of MULLER. The Examiner has not explained the motivation that one of ordinary skill in the art would have had to replace the upsetting stand of Muller with the two high edging stand of Noda. The Examiner on page 2 of the office action states that employing "a conventional edging stand such as that in the compact group of Muller et al. would be an obvious expedient to one skilled in the art." (emphasis added). MPEP 2143.01(IV) recites that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" ... is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Likewise, it appears that the "obvious expedient" reasoning provided by the Examiner is not sufficient to establish a *prima facie* case of obviousness.

Moreover, MPEP 2144.08(A) citing to *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) recites that “[T]he mere possibility that one of the esters or the active methylene group-containing compounds... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious ‘unless the prior art suggested the desirability of [such a] modification’ or replacement.” Also, MPEP 2143.01(II) recites that “Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the Examiner has not explained the motivation that one of ordinary skill in the art would have had to replace the upsetting stand of Muller with the two high edging stand of Noda. It is not sufficient that one of ordinary skill in the art could have made the modification. Rather, the prior art must state the motivation to make the modification. Many combinations are possible however, only the combinations suggested by the prior art are obvious. Applicant respectfully submits that the cited prior art does not suggest or make obvious replacing the upsetting stand of Muller with the two high edging stand of Noda.

The dependent claims of Claim 1, namely, Claims 4 and 12 are also believed to be in condition for allowance for containing additional patentable subject matter and for being dependent upon an allowable base claim 1.

Independent Claim 17 recites similar subject matter as that recited in Claim 1. Hence, Claim 17 is also believed to be in condition for allowance.

**B. Cited Prior Art**

Applicant acknowledges receipt of the cited prior art made of record but not relied upon, but considered pertinent to Applicant’s disclosure. Applicant respectfully submits that the cited prior art, either alone or in combination do not disclose, suggest or make obvious the invention recited in the claims.

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**CONCLUSION**


For the foregoing reasons, Applicant respectfully submits that Claims 1, 4, 12 and 17 are in condition for allowance. An early Notice of Allowance is therefore respectfully requested. Should the Examiner have any suggestions for expediting allowance of the above identified application, the Examiner is invited to contact Applicant's representative at the telephone number listed below.

Should any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: December 11, 2006

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